REMARKS

Claims 1-5 and 11-22 are pending and at issue in the application with claims 1, 21 and 22 being the independent claims. Claims 1, 21 and 22 have been amended. Reconsideration and withdrawal of the rejections in view of the amendments above and the remarks below is respectfully requested.

Interview Summary

On March 26, 2007, the applicant's attorney Aaron M. Peters (Reg. No. 48,801) conducted a telephonic interview with Examiners Umar Cheema and William Vaughn in which independent claim 1 was discussed. A further telephonic interview was conducted on March 27, 2008 with Examiner Vaughn. Although no agreement was reached, Examiner Vaughn indicated that the cited references would be consulted further. The applicant's attorney wishes to thank Examiners Cheema and Vaughn for their time in the interview and for their helpful comments.

The Official Action

The specification was objected to as failing to provide antecedent basis for the claimed subject matter. Claims 21 and 22 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-5 and 11-22 were rejected under 35 U.S.C. § 103 as unpatentable over Giroux et al. (U.S. Pat. No. 6,782,003) in view of Greenspan et al. (U.S. Pat. No. 6,850,484). The applicant respectfully traverses the rejections in light of the above amendments.

Each of claims 1-5 and 11-22 recite a method, apparatus or computer readable medium having computer executable instructions for transferring users' e-mail accounts from a source server to a destination server. Each user email account has associated log on details. When the user logs on to one of the email accounts using the associated log on details via the destination server for the first time, the associated log on details entered by the user are collected, and the transfer of the user's mail folder and its contents from the source server to the destination server is initiated.

During the interview, Examiner Vaughn noted that the term "automatically collect" was not disclosed in the specification. The applicant notes that if a person of ordinary skill in

the art would have understood the inventor to have been in possession of the invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the written description is adequate to support the claim. *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996). While the applicant believes that one of ordinary skill in the art would readily understand that when a user logs on to the destination server with log on details, the destination server automatically collects those log on details (e.g., when a user submits a username and password, the receiving server automatically collects that information), claims 1, 21 and 22 have been amended to remove the term "automatically." It is noted that there is no outstanding rejection of the claims based on this phrase, and this amendment is simply provided in response to the Examiner's unofficial comments.

Turning to the action itself, the specification was objected to as not providing antecedent basis for terms in the claims. As stated in 37 C.F.R. 1.75(d)(1), "[t]he claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find *clear support* or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." (emphasis added). The purpose, as stated in MPEP 608.01(o), is that "sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification," which results in the "use of a confusing variety of terms for the same thing." As seen from the plain language of MPEP 608.01, the objection is directed to "[n]ew claims and amendments to the claims already in the application" and "terms and phrases used in claims presented late in prosecution of the application." The objection only arises if "the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1)." This is not the case here. In compliance with 37 C.F.R. 1.75(d)(1), the terms "an apparatus" and "a computer program product for transferring users' email accounts" find clear support in both the written description and in the claims as originally filed, such that the meaning of these terms is readily ascertainable by one of ordinary skill in the art by reference to the description. Neither of these terms were added by way of amendment so as to create a confusing variety of terms late in prosecution of the application. Accordingly, the objection is improper and must be withdrawn. If the objection is maintained, the applicant requests a detailed explanation as to how these original claim terms lack clear support from the

specification and how the meaning of these original claim terms is not ascertainable by reference to the description.

Turning to the rejection of claims 21 and 22 under 35 U.S.C. § 101, the applicant has amended claim 22 to recite "a computer readable medium" which is accepted language for the purposes of 35 U.S.C. § 101. It should be understood by those of ordinary skill in the art that a "computer program ***product***" as provided in the original claims was clearly meant to refer to a computer readable medium. Accordingly, the rejection of claim 22 under 35 U.S.C. § 101 has been overcome. (MPEP 2106.01).

However, the applicant submits that the rejection of claim 21 is improper and must be withdrawn. In particular, claim 21 recites "***an apparatus*** for transferring users' e-mail accounts," as noted in the action. There is little question that "an apparatus" is structural, and not simply software per se. Even though the claim recites functional features associated with the apparatus, those functional features are nonetheless structurally and functionally interrelated to the apparatus and thus statutory. Further, claim 21 recites a source server and a destination server, and therefore does not "lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. § 101" contrary to the assertion of the action. (See MPEP 2106.01: "… the claim remains statutory irrespective of the fact that a computer program is included in the claim."). Accordingly, the rejection of claim 21 is improper and must be withdrawn.

Turning to the prior art rejections, the applicant respectfully submits that none of claims 1-5 or 11-22 are rendered unpatentable over Giroux et al. in view of Greenspan et al. Each of claims 1-5 and 11-22 recite, in one manner or another, collecting log on details entered by the user as the user logs on via the destination server for the first time and initiating the transfer of the user's mail folder and its contents from the source server to the destination server. The log on details used to log on via the destination server are the same log on details used for accessing the email account residing on the source server (i.e., used to log on via the source server). As a result, email accounts may be automatically transferred in response to logging on via to the destination server using the same log in details as were used to log on to the source server. Simply put, neither Giroux et al. nor Greenspan et al. disclose logging on via a destination server using the log on details of the source server in order to initiate the transfer.

In particular, on page 5 the action states that Giroux et al. "does not disclose wherein setting up destination server to act as a gateway and each email account having associated log on details wherein one of the email account having associated log on details via the destination server." Although awkwardly worded, the action appears to acknowledge that Giroux et al. does not disclose using the log on details of the source server in order to log on via the destination server and initiate the transfer. Nonetheless, it is clear that this feature is not disclosed by simply reviewing the disclosure of Giroux et al.

While Giroux et al. discloses a method and system for replicating data on a source to a destination, the method and system utilizes an intermediary by which a user initiates the transfer from the source to the destination. As disclosed by Giroux et al., the system includes an old application service provider (ASP) 110 (i.e., the source), a new ASP 120 (i.e., the destination) and an ASP server 160. The ASP server 160 acts as an intermediary between the old ASP 110 and the new ASP 120 (see col. 2, lines 35-38; col. 4, lines 41-43; Fig. 3). The ASP server 160 is neither the source nor the destination. A routine 400 resides on the intermediary ASP server 160 and is responsible for transferring the data from the old ASP 110 to the new ASP 120 (see col. 5, lines 14-29). The functions of the routine 400 are shown in Fig. 4, and are summarized as follows. Initially, the routine 400 waits for a user to initiate the transfer of data from the old ASP 110 to the new ASP 120, after which the routine 400 requests information from the user (i.e., log on details) using a form so that the routine 400 may access the old ASP account (see col. 5, lines 51-67). Once the ASP server 160 has this information, the routine 400 accesses the user's account on the old ASP 110 (see col. 5, lines 61-67). Only after the ASP server 160 accesses the users email account on the old ASP 110 and receives personal data and organizational structure from the old ASP 110 is the data uploaded to the new ASP 120 (see col. 6, lines 44-46). However, in order to access the new ASP 120 and upload the data, a new email account must be created (see col. 6, lines 47-56), after which the new ASP 120 may be accessed using the new email account and the data uploaded from the ASP server 160 to the new ASP 120 (see col. 6, lines 57-13).

Accordingly, it is evident simply from reading the steps disclosed in Giroux et al. that the only entry of the log on details of the old ASP 110 is done via the intermediary ASP server 160; not the new ASP 120 (i.e., not via the destination). Even when the log on details are provided to the ASP server 160, they are not used to log on via either the ASP server 160 or the new ASP 120. They are simply provided in a form so that the ASP server 160 can

access the account on the old ASP 110. Even when the user logs on via the new ASP 120, thereby completing the transfer to the new ASP 120, the user only does so using the log on details of the new account (i.e., log on details of the new ASP 120), as required by the routine 400. Giroux et al. simply does not disclose logging on via the new ASP 120 using the log on details of the old ASP 110 in order to initiate the transfer. To interpret Giroux et al. otherwise would ignore the plain teachings of Giroux et al. By contrast, each of claims 1-5 and 11-22 recite, in one manner or another, logging on via a destination server using the log on details of a source server in order to initiate the transfer.

During the interview, Examiner Vaughn pointed to Fig. 5 of Giroux et al. for the proposition that the user logs on to the email account via new ASP 120 (i.e., the destination) using the log on details of the old ASP 110 (i.e., the source). This is incorrect. Fig. 5 is a form displayed as part of the routine 400 (see col. 5, lines 51-60). Giroux et al. clearly discloses that the routine 400 resides on the ASP server 160 (see e.g., col. 5, lines 1-5; col. 5, lines 19-24; col. 5, lines 61-67). While the software may be executed from other locations (col. 4, lines 57-65), it remains that Giroux et al. does not disclose the routine 400 residing on either the old ASP 110 or the new ASP 120. It further remains that even if the routine 400 were to reside on either the old ASP 110 or the new ASP 120, the routine 400 requires the creation of a new account, which is the only account used to log on via the new ASP 120 in order to complete the transfer. In short, the log on details of the old ASP 110 are not even provided to the new ASP 120, much less used to log on via the new ASP 120. The entry of the log on details in the form of Fig. 5 are only provided to the intermediary ASP server 160, and even then the log on details are only provided to the ASP server 160; not to log on to via the ASP server 160.

Accordingly, as acknowledged in the action, Giroux et al. does not disclose a destination server set up as a gateway. Further, Giroux et al. clearly does not disclose collecting log on details associated with a source server and entered by the user *as the user logs on via the destination server for the first time using those same log on details*, thereby initiating the transfer of the user's mail folder and its contents from the source server to the destination server, as recited in claims 1-5 and 11-22.

Like Giroux et al., Greenspan et al. does not disclose logging via a destination server using the log on details of the source server in order to initiate the transfer. While Greenspan

et al. discloses redirecting and managing messaging and information access in a network using a stream manager as a gateway for a group of destination site servers, the stream manager is not a destination server and a user does not log on via the stream manager using log on details of a source server. Instead, the stream manager simply determines the availability of a destination server to receive and process a message (see Abstract). Accordingly, the stream manager is not a destination server that acts as a gateway, as recited in claims 1-5 and 11-22.

The action is also incorrect in citing the IP addresses of the user and destination as corresponding to log on details of a source server that are used to log on via a destination server to initiate transfer. Simply put, different IP addresses are used: "IP(user)" and "IP(destination)" (see col. 2, line 55 to col. 3, line 5). The user's gateway (i.e., source) uses "IP(user)" and the destination server uses "IP(destination)." These IP addresses are simply used to route data messages. The user and destination do not use the same IP address (i.e., log on details associated with a source server, as alleged in the action). While the destination server may reply by reversing the IP addresses, again this is only for routing purposes. "IP(user)" (i.e., log on details associated with a source server) is simply not used to "log on" via the destination server.

Accordingly, Greenspan et al. does not disclose a destination server set up as a gateway and also does not disclose collecting log on details associated with a source server and entered by the user *as the user logs on via the destination server for the first time using those same log on details*, thereby initiating the transfer of the user's mail folder and its contents from the source server to the destination server, as recited in claims 1-5 and 11-22.

It is clear that in order for a claim to be rendered unpatentable, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See MPEP 2143.03. As required by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007), the differences between the claimed invention and the prior art must still be ascertained, and both the invention and the prior art references must be considered as a whole. See MPEP 2141. That is, all claim limitations must be still disclosed in the prior art. Accordingly, the combination of Giroux et al. and Greenspan et al. does not disclose or suggest all of the limitations of claims 1-5 and 11-22, because neither reference discloses

logging on via a destination server using the log on details of the source server in order to initiate the transfer.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested. As a result of the above amendments, 3 independent claims remain in the application as previously paid for, and 17 total claims remain in the application as previously paid for. This response is being timely filed with a one month extension of time and small entity fee of $60.00. The applicant believes no additional fee is due. However, the commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 13-2855. Should the examiner wish to discuss the foregoing, or any matter of form, in an effort to advance this application towards allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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